

3624 THW

ATTORNEY DOCKET NO. 114459-05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/370,619 Confirmation No.: 8285
Applicant: Michael D. Erlanger
Title: EFFICIENT MARKET FOR FINANCIAL PRODUCTS
Filed: August 7, 1999
Art Unit: 3624
Examiner: Ella Colbert

Atty. Docket: 114459-05
Customer No. 38492

REQUEST FOR CLARIFICATION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is not a "response" to the Restriction Requirement of November 3, 2005. Rather, it is a note that the paper of November 3, 2005 is incomplete. Applicant respectfully requests withdrawal of the November paper, and either examination of the application in accordance with the election filed August 15, 2005, or a completed Requirement for Restriction.

I. The Paper of August 15, 2005 Made A Proper Election

Attached herewith is a corrected replacement copy of Applicant's paper of August 15, 2005. (In a telephone interview, the Examiner indicated that the PTO's file copy was not legible.) On page 4, lines 3-4, there is an election of Group II, with traverse, as follows:

In a third alternative, Applicant elects Group II as proposed in August 2005, claims 187-251, 299 and 300, with traverse.

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on December 6, 2005 as First Class Mail in an envelope with sufficient postage, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

It is believed that this is a fully complete election, and that examination should proceed on this basis (if none of the other previous alternatives are acceptable), pursuant to 37 C.F.R. § 1.143.¹

If this election is somehow incomplete or defective, Applicant requests clarification, so that further frustration of the Examiner's expectations can be avoided.

II. The Paper of November 2005 is Incomplete

Sections I and II of the paper of August 15, 2005 raises to issues, under MPEP § 803.01 and § 803 (based on *In re Lee*): it is "IMPORTANT ... THAT NO REQUIREMENTS BE MADE," and that "restriction should not be required" in the circumstances of this case. MPEP § 803.01 and § 803 make clear that these considerations override all other discretionary reasons for restriction, such as the ones relied on in the August 11, 2005 and November 3, 2005 papers.

No response to this ground of traverse is apparent in the November 2005 paper. Applicant notes that the first time the MPEP § 803.01 issue was raised was in the paper of August 15, 2005, and thus there cannot have been any response to this issue in any previous paper.

Until there is some explanation for why these two provisions of the MPEP do not apply to this application, Applicant is unable to respond further.

¹ 37 C.F.R. § 1.143 reads as follows:

§ 1.143 Reconsideration of requirement.

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

III. Classification of Several Groups

Applicant and Examiner have agreed that the following search classes are generally within a reasonable ballpark:

- 705/1 (“Automated Electrical Financial Or Business Practice Or Management Arrangement”)
- 705/35 (“Finance (e.g., banking, investment or credit)”)
- 705/37 (“Trading, matching, or bidding”)
- 705/38 (“Credit (risk) processing or loan processing (e.g., mortgage)”)

However, class 707/30 is directed to “accounting,” subject matter drawn to “recording, analyzing, verifying, or reporting of funds or other quantitatively innumerable factors used in a business.” None of the independent claims recite words normally associated with “accounting” such as “asset,” “liability,” “credit,” “debit,” “revenue,” “cash flow,” “income,” “earnings,” “balance sheet,” or the like. Likewise, 705/39 is directed to “funds transfer or credit transaction,” subject matter drawn to “transferring funds by debiting one account and crediting another by the same amount.” None of the independent claims recite such offsetting debits and credits.

705/30 and 705/39 will not result in efficient searches of this subject matter. Applicant respectfully requests that the claims be grouped in the classes agreed to be reasonable, set forth above.

IV. No Petition for Extension of Time is Required

Because the August 15, 2005 paper was fully responsive, the November 3, 2005 paper should not have been issued, at least not in its present form. Therefore no response is required, and no extension of time is required for this paper.

Nonetheless, a conditional petition for extension is stated below.

V. Conclusion

Until the Examiner’s position is fully stated, and the defect or inadequacy in the “third alternative” election identified above is squarely identified, Applicant can only reiterate the previous arguments under MPEP § 803 and 803.01, and restate provisional elections in the same manner as before. This is frustrating for both the examiner and the Applicant. Applicant

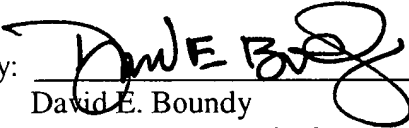
respectfully requests a response to the issues identified in §§ II and III above, and examination of one of the elected groups. Because the third alternative election (see § I of this paper) is exactly one of the groups as posed by the Examiner, Applicant suggests at the very least Rule 143 applies, and that that group should be examined with no further delay.

In view of these remarks, Applicant respectfully submits that the claims are in condition for examination and allowance. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114459-05.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: December 6, 2005

By: 
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